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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/931,703	08/16/2001	Gregory Booker	JBP-561	3432

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EXAMINER	
DELCOTTO, GREGORY R	
ART UNIT	**PAPER NUMBER**
1751	

DATE MAILED: 03/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/931,703	BOOKER ET AL	
	Examiner	Art Unit	
	Gregory R. Del Cotto	1751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-37* is/are pending in the application.

4a) Of the above claim(s) *26 and 34* is/are withdrawn from consideration.

5)☒ Claim(s) *30-33 and 35-37* is/are allowed.

6)☒ Claim(s) *1-9,11-25 and 27-29* is/are rejected.

7)☒ Claim(s) *10* is/are objected to.

8)☒ Claim(s) *1-37* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *multiple*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-37 are pending.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-25, 27-33, and 35-37, drawn to moisturizing detergent composition, classified in class 510, subclass 119.

II. Claims 26 and 34, drawn to a method of using the composition to impart a moisturizing residue to skin, classified in class 424, subclass 70.11.

The inventions are distinct, each from the other because of the following reasons:

Inventions of Group I and Group II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the invention of Group I can be used in a materially different process such as in a method of cleaning textiles.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

During a telephone conversation with Michelle Mangini on February 20, 2004, a provisional election was made with traverse to prosecute the invention of Group I, claims 1-25, 27-33, and 35-37. Affirmation of this election must be made by applicant in replying to this Office action. Claims 26 and 34 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-9, 11-25, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Steer (US 6,627,585).

A mousse-forming cleansing shampoo composition having improved conditioning performance comprising a foamable concentrate containing at least one surfactant, dispersed particles of a water-insoluble conditioning agent having a particle size of 1 micron or greater; an aqueous carrier and an aerosol. See Abstract. Hair conditioning oily or fatty materials are preferred conditioning agents in compositions for adding shine to the hair and also enhancing dry combing and dry hair feel. Suitable fatty esters are characterized by having at least 10 carbon atoms, and include esters with hydrocarbyl chains derived from fatty acids or alcohols, e.g., monocarboxylic acid esters, polydric alcohol esters, and di- and tricarboxylic acid esters. The monocarboxylic acid ester includes isopropyl isostearate, hexyl laurate, isohexyl laurate, oleyl adipate. Di- and trialkyl and alkenyl esters of carboxylic acids can also be used. These include for ester of C4-C8 dicarboxylic acids such as esters C1-C22 esters of succinic acid, glutaric acid, etc. Particularly preferred fatty esters are mono-, di-, and triglycerides, more specifically the mono-, di-, triesters of glycerol and long chain carboxylic acids such as C1-C22 carboxylic acids. Note that, the Examiner asserts that the esters as taught by Steer would be encompassed by the broad terminology of "mono, di- and tri- ester" as recited by the instant claims. The hair conditioning oily or fatty material is typically

present at a present at a level of from 0.05% to 10% by total weight of oily or fatty material based on the total weight of the foamable concentrate. See column 7, lines 1-69.

The compositions may also contain a surfactant. Suitable surfactants include anionic and nonionic surfactants. Amphoteric and zwitterionic cleansing surfactants include alkyl amine oxide, alkyl betaines, alkyl amidopropyl betaines, etc. The total amount of surfactant is generally from 3 to 50% by weight of the foamable concentrate. See column 9, lines 13-20. Additionally, the compositions may contain a deposition polymer for the dispersed particles of conditioning agent. Suitable cationic deposition polymers include copolymers of vinyl monomeers having cationic amine or quaternary ammonium functionalities. Other cationic deposition polymers that can be used include cationic guar gum derivatives such as guar hydroxypropyltrimonium chloride, etc. See column 9, line 13 to column 10, line 60.

Steer does not specifically teach a detergent composition containing a cationic polymer, a diester or triester emollient, a monoester emollient, a cleansing surfactant and the other requisite components of the composition in the specific proportions as recited by the instant claims.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to formulate a detergent composition containing a cationic polymer, a diester or triester emollient, a monoester emollient, a cleansing surfactant and the other requisite components of the composition in the specific proportions as recited by the instant claims, with a reasonable expectation of success and similar

results with respect to other disclosed components, because the broad teachings of Steer suggest a detergent composition containing a cationic polymer, a diester or triester emollient, a monoester emollient, a cleansing surfactant and the other requisite components of the composition in the specific proportions as recited by the instant claims.

Claims 1-9, 11-25, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Evans et al (US 5,837,661).

Evans et al teach hair conditioning shampoo compositions comprising from about 5% to about 50% by weight of a detersive surfactant, from about 0.05% to about 10% by weight of a silicone hair conditioning agent, from about 0.1% to about 10% by weight of a suspending agent, from about 0.025% to about 1.5% by weight of selected polyalkylene glycols, and water, and optionally one or more additional materials known for use in shampoo or conditioning compositions. See Abstract. The surfactant concentration ranges from about 5% to about 50% by weight and suitable surfactants include anionic surfactants, nonionic surfactants, amphoteric and zwitterionic surfactants, etc. See column 2, line 50 to column 6, line 69. Suitable suspending agents include ethylene glycol esters of fatty acids such as ethylene glycol stearates, both mono- and distearate, long chain esters of long chain fatty acids (stearyl stearate, cetyl palmitate), glyceryl esters, ling chain esters of long chain alkanol amides, ethylene glycol esters of long chain carboxylic acids, etc. Additionally, cationic polymers for use as hair conditioning agents having a weight average molecular weight of from about 5000 to about 10 million, and will generally have cationic, nitrogen-containing moieties

such as quaternary ammonium or cationic amino moieties, and mixtures thereof. See column 17, line 65 to column 68, line 15.

Evans et al does not specifically teach a detergent composition containing a cationic polymer, a diester or triester emollient, a monoester emollient, a cleansing surfactant and the other requisite components of the composition in the specific proportions as recited by the instant claims.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to formulate a detergent composition containing a cationic polymer, a diester or triester emollient, a monoester emollient, a cleansing surfactant and the other requisite components of the composition in the specific proportions as recited by the instant claims, with a reasonable expectation of success and similar results with respect to other disclosed components, because the broad teachings of Evans et al suggest a detergent composition containing a cationic polymer, a diester or triester emollient, a monoester emollient, a cleansing surfactant and the other requisite components of the composition in the specific proportions as recited by the instant claims.

Claims 1-9, 11-25, and 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 95/00116.

'116 teaches a system for cleansing the skin comprising a hydrophobic diamond-mesh sponge and a liquid cleansing and moisturizing composition with excellent lather in the same washing and rinsing operation. The system provides improved lather and overall acceptability for mild liquid cleansing compositions which contain moisturizers

and especially for those which would otherwise have marginal lather. See Abstract. The liquid cleanser can contain from about 0.5% to about 15% of a lipophilic emollient moisturizer selected from the group consisting of esters of fatty acids, glycerin mono-, di-, and tri-esters, epidermal and sebaceous hydrocarbons such as cholesterol, cholesterol esters, etc. Additionally, surfactants may be used in the compositions and suitable surfactants include anionic, nonionic, amphoteric, zwitterionic, and cationic. See page 8, lines 1-30. The liquid cleanser can be made by using from 0.1% to 5% of a skin moisturizing cationic polymer selected from the group consisting of cationic polysaccharides and derivatives, etc. See page 11, lines 1-30. Note that, '116 teaches the use of Polyquaternium-10 as a suitable conditioning agent. See page 15, lines 1-5.

'116 does not specifically teach a detergent composition containing a cationic polymer, a diester or triester emollient, a monoester emollient, a cleansing surfactant and the other requisite components of the composition in the specific proportions as recited by the instant claims.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to formulate a detergent composition containing a cationic polymer, a diester or triester emollient, a monoester emollient, a cleansing surfactant and the other requisite components of the composition in the specific proportions as recited by the instant claims, with a reasonable expectation of success and similar results with respect to other disclosed components, because the broad teachings of '116 suggests a detergent composition containing a cationic polymer, a diester or triester emollient, a monoester emollient, a cleansing surfactant and the other requisite

components of the composition in the specific proportions as recited by the instant claims.

Allowable Subject Matter

Claim 10 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 30-33 and 35-37 are allowed.

None of the references of record, alone or in combination, teach or suggest a composition containing the requisite components in the specific proportions as recited by the instant claims.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-9, 11-25, and 29 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 20 of copending Application No. 09/954335. Although the conflicting claims are not identical,

they are not patentably distinct from each other because claim 20 of 09/954335 encompasses the material limitations of the instant claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Remaining references cited but not relied upon are considered to be cumulative to or less pertinent than those relied upon or discussed above.

Applicant is reminded that any evidence to be presented in accordance with 37 CFR 1.131 or 1.132 should be submitted before final rejection in order to be considered timely.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory R. Del Cotto whose telephone number is (571) 272-1312. The examiner can normally be reached on Mon. thru Fri. from 8:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on (571) 272-1316. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gregory R. Del Cotto
Primary Examiner
Art Unit 1751

GRD
February 24, 2004